

PATENT APPLICATION
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q91735

Toshinori ISOBE, et al.

Appln. No.: 10/559,378

Group Art Unit: 1793

Confirmation No.: 2890

Examiner: Kevin M JOHNSON

Filed: December 6, 2005

For: ULTRAVIOLET EXCITED LIGHT-EMITTING DEVICE

APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705

MAIL STOP PATENT EXTENSION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

*File
date*

Applicant hereby respectfully requests correction of the Patent Term Adjustment (PTA) listed in the Notice of Allowance mailed December 3, 2009 from 339 days to 344 days. This reflects the USPTO's incorrect use of December 11, 2005 as the '378 Application's filing date for calculating USPTO delay under 37 C.F.R. § 1.703, rather than December 6, 2005, which was the date on which the '378 Application fulfilled the requirements of 35 U.S.C. § 371.

In accordance with 37 C.F.R. § 1.705(b) this Application for Patent Term Adjustment is being filed on the same day as the issue fee is being paid, and is therefore timely filed. The Director is authorized to charge Patentee's Deposit Account 19-4880 for the required fee as specified in 37 C.F.R. § 1.18(e) (\$200.00).

As required by §§ 1.705(b)(2), a Statement of the Facts is set forth below. For the purposes of clarity, references to "this Application" refer to the present Application for Patent Term Adjustment, whereas references to "the '378 Application" refers to this U.S. Application No. 10/559,378.

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I. Statement of the Facts

A. The correct patent term adjustment and the basis or bases under §1.702 for the adjustment

Pursuant to §§ 1.702(a), Applicant submits that the total correct patent term adjustment for the '378 Application should be 344 days. As discussed in further detail below, this number is derived from the sum of the Office's delay calculated from §§ 1.702(a-e) (433 days under § 1.703(a)), minus the sum of Applicant's delay calculated from § 1.704 (89 days).

B. Delay attributable to the USPTO (the relevant dates as specified in §§1.703(a) through (e) for which an adjustment is sought)

Patentee respectfully submits that the total delay attributable to the USPTO under 37 C.F.R. § 1.703 is 433 days, rather than the 428 days previously calculated by the USPTO. The error in the USPTO's calculation is the result of its use of December 11, 2005 as the date in which the requirements of 35 U.S.C. § 371 were met, rather than the correct date of December 6, 2005, which is the actual date that the requirements of 35 U.S.C. § 371 were met.

The delay attributable to the USPTO results from a delay of 433 days under 37 C.F.R. § 1.703(a)(1). In particular, the '378 Application met the requirements of 35 U.S.C. § 371 on December 6, 2005, as acknowledged by the USPTO on the Official Filing Receipt. However, the first Office Action did not issue until April 14, 2008. Thus, under 37 C.F.R. § 1.703(a)(1) this represents a 433 day delay between the 14-month anniversary of the '378 Application's base date and the date in which the first Office Action issued.

Based upon Applicant's review of PAIR, it appears that the USPTO incorrectly calculated its delay under 37 C.F.R. § 1.703(a)(1) as being only 428 days because it incorrectly stated that the "371 Completion Date" was December 11, 2005, instead of the correct December 6, 2005. See the attached printout of the PTA calculation obtained from PAIR. The use of December 11, 2005 instead of December 6, 2005 is contrary to the both the statute (35 U.S.C. § 154) and the USPTO's own regulations (37 C.F.R. § 1.703(a)(1)) regarding patent term adjustment, both of which state that the time is calculated from the date in which the application

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meets the requirements of 35 U.S.C. § 371. Applicant notes that the statute specifically states that the relevant time period is calculated based on the date on which the application “fulfilled the requirements of section 371.” Similar language is found in 37 C.F.R. § 1.703(a)(1). The use of December 11, 2005 as the 371 date in the ‘378 Application, when the ‘378 Application actually fulfilled the requirements of 35 U.S.C. § 371 on December 6, 2005 is incorrect at best, and arbitrary and capricious at worst since no authority has been cited to deny Applicant its December 6, 2005 filing date.

In addition, Applicant notes that in the transmittal letter filed on December 6, 2005 in the ‘378 Application, it was “expressly requested that the national stage of processing be commenced immediately in accordance with 35 U.S.C. § 371(f).” See page 2 of the transmittal letter of December 6, 2005, attached. Thus, there is no reason that the 371 date for the ‘378 Application should not have been December 6, 2005.

Accordingly, Applicant respectfully submits that the delay attributable to the USPTO under 37 C.F.R. § 1.703(a)-(e) is 433 days.

C. Delay attributable to Patentee (any circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination as set forth in § 1.704)

Applicant respectfully submits that the total delay attributable to the Applicant under 37 C.F.R. § 1.704 is 89 days, as already noted by the USPTO. This delay stems from the 89 day delay under 37 C.F.R. § 1.704(b) between the USPTO’s mailing of the October 17, 2008 Office Action and Applicant’s April 16, 2009 Response.

In view of the above, the total delay incurred by Applicant in the ‘378 Application is 89 days.

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D. Whether the application is subject to a terminal disclaimer and any expiration date specified in the terminal disclaimer

The '378 Application is subject to a Terminal Disclaimer naming U.S. Application No. 10/556,680, now U.S. Patent No. 7,622,057. The '057 Patent is due to expire May 28, 2025, although Applicant notes that the expiration date of the '057 Patent may be affected by the Federal Circuit's recent opinion in *Wyeth v. Dudas*.

E. The adjustment as specified in 37 C.F.R. § 1.703(f) to which the '378 Application is entitled

The total amount of patent term adjustment is specified in 37 C.F.R. § 1.703(f) as being the period of delay attributable to the USPTO under 37 C.F.R. §§ 1.703(a-e) less the amount of delay attributable to Applicant under 37 C.F.R. § 1.704. Accordingly, the '378 Application is entitled to 344 days of PTA. This number is derived from the sum of the delay attributable to the USPTO under §§ 1.702(a-e) (433 days), minus the sum of the delay attributable to Applicant under § 1.704 (89 days).

II. Conclusion

In summary, Applicant respectfully submits that it is proper that the USPTO grant Applicant's Application for Patent Term Adjustment. Favorable consideration is respectfully requested.

Respectfully submitted,



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